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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,782	11/12/2003	Ping Jiang	312762004100	7794

25225 7590 09/11/2006

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EXAMINER

SANG, HONG

ART UNIT PAPER NUMBER

1643

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/712,782	JIANG ET AL.	
	Examiner	Art Unit	
	Hong Sang	1643	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): new matter rejection.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2 and 5-11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER

Continuation of item 11: The request for reconsideration has been considered but does NOT place the application in condition for allowance.

The previous 103(a) rejection is maintained.

The response states that the claims now require separating the labeled cells "mechanically" from the surrounding tissue, i.e. the separation is "surgical" as in former claim 3. This distinguishes the invention as now claimed from the primary document, Hadjantonakis, which describes only cell sorting by flow techniques. Trumper does not teach mechanical (or surgical as in canceled claim 3) separation of one or more desired cells from surrounding tissue based on cell surface staining and/or cell morphology because Trumper's reference teaches that single-cell suspensions are prepared from fresh tissue and then individual cells are identified using a phase-contrast microscope after being plated on a surface. This is not a mechanical separation from surrounding tissue or a surgical technique. Surgery involved manipulation of actual tissues, not picking individual cells from a surface on which they individually are plated, and thus already separated from surrounding tissue. The cells in Trumper are already separated from surrounding tissue when they are removed from the surface. Accordingly, Trumper does not suggest the technique that is used to separate the fluorescent cells as required by the claims and fails to overcome the deficiency in the preliminary document.

Applicants' arguments have been carefully considered but are not found persuasive. The amended claim 1 is drawn to a method to recover one or more fluorescent cells from a tissue, which method comprises mechanically separating one or more living cells that produce a fluorescent protein from surrounding tissue containing cells that do not produce said first fluorescent protein, thereby recovering one or more living cells that produce said first fluorescent protein, separate from any cells that do not produce said first fluorescent protein. Hadjantonakis teaches manual dissection of a region of interest (tissue that comprises GFP expressing cells) from a subject (see page 56, Fig.4). Therefore, Hadjantonakis teaches mechanical separation of the GFP expressing cells from surrounding tissue. Hadjantonakis further teaches the individual GFP labeled cells can be recovered by enzymatic dissociating of the tissue into single cell suspension, and further flow sorting. While Hadjantonakis does not teach mechanical separation of one or more GFP expression cells from GFP non-expressing cells, these deficiencies are made up for in the teachings of Trumper. Trumper teaches that viable single-cells (comprising both stained and non-stained cells) can be separated from fresh tissue (lymph nodes) by mincing the tissue in RPMI 1640 medium and pressing the minced tissue gently through a stainless steel mesh (see page 3098, left column, last paragraph). Therefore, Trumper teaches mechanical separation of one or more cells from surrounding tissue. Trumper further teaches identifying individual cells based on staining antibodies and/or morphology using phase-contrast microscope, and selecting the desired cell under inverted microscope with the help of a micromanipulator (see page 3096, last paragraph, page 8907, 1st paragraph and Figure 1). Therefore, Hadjantonakis and Trumper together teach every limitations of claim 1.

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Art Unit: 1643
Aug. 30, 2006



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